

### **REMARKS**

The indication that claim 13 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in the Office Action and to include all of the limitations of the base claim and any intervening claims, and that claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, is acknowledged.

By the above amendment, claims 13 and 14 have been rewritten in independent form to incorporate the features of the parent claim therein, with claim 13 being amended in a manner which is considered to overcome the rejection under 35 U.S.C. 112, as will be discussed below. Additionally, claim 12 has been amended to depend from claim 13 so that claim 12 should be considered allowable with parent claim 13, and further, in light of the rejections of claims 1-10 and 13 under 35 U.S.C. 112, second paragraph, claims 1-10 as well as claim 11 has been canceled without prejudice or disclaimer of the subject matter thereof, and new claims reciting the method and apparatus in compliance with 35 U.S.C. 112, second paragraph, have been presented.

Turning first to the objection to the disclosure that in claim 11, line 8, "a specimen and" should be deleted, such objection is traversed and reconsideration and withdrawal thereof is respectfully requested. Applicants note that the portion of claim 11 objected to by the Examiner recites "an electron energy filter is provided between an electron detector detecting an electron beam transmitting a specimen and the specimen" (emphasis added). Referring to Fig. 2 of the drawings of this application as shown therein, an electron gun 1 radiates a specimen held by the specimen holder 11 with an electron beam and an electron energy filter 6 as well as an electron detector 8 are disposed below the specimen in which the electron detector 8 detects an electron beam transmitting the specimen with the electron

energy filter 6 being disposed between the specimen which is held by the specimen holder 11 and the electron detector 8. Thus, applicants submit that the language of claim 8 properly describes the location of the electron energy filter as between the specimen and the electron detector, such that the objection to the language of claim 11 should be overcome. Applicants note that by the present amendment, claim 11 has been canceled with the features thereof incorporated into dependent claims 13 and 14 which have been written in independent form and to clarify the language objected to by the Examiner, now recite "an electron energy filter is provided between an electron detector of the imaging system which detects an electron beam transmitting the specimen and the specimen". Applicants submit that such language should be considered appropriate.

With regard to the rejection of claim 13 under 35 U.S.C. 112, second paragraph, as being indefinite for reciting the limitation "similarity...the result" in lines 2-7 with the Examiner indicating "What are the elements that are the similarity between observed image and the reference image?", applicants have revised claim 13 to recite the features "wherein in an image analysis part and an image display part, an observed image of virus or protein included in the specimen and a reference image of known virus or protein are compared and subjected to quantitative analysis using imaging processing software, and the species of virus or protein or the species of a substance in the specimen is identified as a result of the comparison so as to display the result." Applicants submit that this language overcomes the indefiniteness noted by the Examiner and should be considered to be in compliance with 35 U.S.C. 112, second paragraph. Applicants note that other claims have been presented which utilize similar language and all claims present in this application are considered to be in compliance with 35 U.S.C. 112, second paragraph.

With regard to the rejection of claims 1-10 under 35 U.S.C. 112 and 35 U.S.C. 101, as noted above, such claims have been canceled by the present amendment

and new claims corresponding thereto have been presented. More particularly, new independent claim 16 and dependent claims 17-20 recite the feature of an observation method and set forth steps for performing the method in a manner which is considered to be in compliance with 35 U.S.C. 112 and 35 U.S.C. 101. Further, a new independent claim 21 directed to the bioelectron microscope in an apparatus format and dependent claims 22-25 have been presented reciting the features thereof in a proper apparatus format so that these claims should also be considered to be in compliance with 35 U.S.C. 112, second paragraph and 35 U.S.C. 101. Additionally, by the present amendment, a new dependent claim 15 dependent from claim 14, which should be in condition for allowance, has been presented.

With regard to independent claims 16 and 21, applicants note that each of these independent claims recite the features of the present invention including a recipe server storing at least one of recipes including a recipe of an emission current of the electron gun, recipe of an exciting current of one of the plurality of lenses and a recipe of a position of the electron beam aperture as well as recite other features. Applicants submit that such features as well as the other features of the independent and dependent claims are not disclosed or taught in the cited art, and all claims patentably distinguish thereover and should be considered allowable at this time.

As to the rejection of claims 11 and 12 under 35 U.S.C. §102(b) as being anticipated by Krivanek (5,640,012), this rejection is considered to be obviated by the cancellation of claim 11 and the amendment of claim 12 to depend from claim 13, which has been written in independent form and should be allowable. Applicants note that Krivanek does not disclose or teach the recited features of independent claims 16 and 21 and the dependent claims thereof.

In view of the above amendments and remarks, applicants submit that all claims present in this application should now be in condition for allowance, and issuance of an action of a favorable nature is courteously solicited.

To the extent necessary, applicant's petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 01-2135 (520.42819X00) and please credit any excess fees to such deposit account.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read 'Melvin Kraus', is written over a horizontal line.

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